

Appl. Ser. No: 10/800,188
Office Action Mailed: 12/15/2004 (December 15, 2004)
Reply to Office Action Dated: 05/06/2005 (May 6, 2005)

Page 7 of 11

III. REMARKS/ARGUMENTS

A. Generally

The informalities of claims 11 and 13 have been corrected in amendments to the claims in accordance with the Examiner's indications.

The informality of claim 9 has been addressed in the amendment to claim 1 by providing the antecedent basis for "said back side".

Claim 1 has been amended to include patentably distinguish over the cited references. Specifically, claim 1 has been amended in the following ways:

- First, to recite in its preface that the inventive wall fastener locating and marking tool is for aiding in the location and placement on walls of planar articles having wall fastener hardware
- Next, to recite that the vertical member has a front side and a back side;
- Next, to recite that the handle portion is disposed from the upper end of the vertical member and extending outwardly from the front side, such that it is disposed over the top of the planar article when in use; and
- Finally, to recite that the structure of the apparatus is such as to provide an apparatus whereby when the apparatus is in use, the planar article is suspended by its wall fastener hardware by the retention means and is disposed between the handle portion and the front side of the vertical member.

B. Response to Rejections Based on 35 U.S.C. § 103(a)

The Examiner has indicated that claims 1-8, 10-12, 19 and 20 are rejected under 35 U.S.C. 103(a) as unpatentable over Hofmeister et al. (US 6,739,065) in view of Wegman (US 6,026,584); that claim 9 is rejected under 35 U.S.C. 103(a) as unpatentable over Hofmeister in view of Wegman as applied to claims 1-8, 10-12, 19 and 20, and further in view of Krake et al.

Appl. Ser. No: 10/800,188
Office Action Mailed: 12/15/2004 (December 15, 2004)
Reply to Office Action Dated: 05/06/2005 (May 6, 2005)

Page 8 of 11

(US 2002/0078582]; that claims 13-16 are rejected under 35 U.S.C. 103(a) over Hofmeister in view of Wegman as applied to claims 1-8, 10-12, 19 and 20, and further in view of Bogart (Pat. No. not available).

As set forth in MPEP 2143.01:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

And:

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Furthermore, a long line of cases stand for the proposition that when the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination. *Heidelberger Druckmaschinen v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 30 U.S.P.Q.2d 1377, 1379 (C.A.F.C.1994); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931,934,15 U.S.P.Q.2d1321, 1323 (C.A.F.C.), cert. denied, 498 U.S. 920 (1990); *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276,127 (C.A.F.C.1987). The mere fact that the prior art *may* be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783-84 (C.A.F.C. 1992); *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (C.A.F.C. 1984).

Appl. Ser. No: 10/800,188
Office Action Mailed: 12/15/2004 (December 15, 2004)
Reply to Office Action Dated: 05/06/2005 (May 6, 2005)

Page 9 of 11

The question is not whether what is claimed *could* have been done, but rather whether it was *obvious* to do so in light of all the relevant factors. *Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 119 F.3d 953,957, 43 U.S.P.Q.2d 1294, 1297 (C.A.F.C.1997).

And finally:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

The examiner has provided a well ordered listing of all of the elements he found in the reference art. Among other things, it is noted in the list that Hofmeister includes retention means 260 for bearing an object by its wall fastener hardware during use. Applicant respectfully disagrees. Element 260 in Hofmeister is a pin employed only to provide a surface against which a toothed hanger can be placed for securing the picture hanging device 10 onto the back of an object 700 and urging the top side 710 of the object against the underside of the ledge 30. However, the pin 260 does not bear the weight of the article during use. Nothing in the device in Hofmeister bears the weight of the object during use.

Furthermore, neither Hofmeister nor Wegman, alone or in combination, shows an apparatus having means to suspend a planar article, such that when the article is so suspended it is disposed between the handle portion and the front side of the vertical member. In fact, there is no handle in Hofmeister. When the device in Hofmeister is employed, the user holds the frame of the object being hung and applies pressure to the frame to mark the wall. [See FIG. 7 and col. 5, lines 50-col 6, line 21.]

In Wegman, the handle 42 extends rearwardly from the vertical member, which places all of the apparatus structure behind the planar article when employed.

There is no suggestion or teaching in either of the references to attach a handle to Hofmeister, and if the handle in Wegman were so attached, it would render Hofmeister

Appl. Ser. No: 10/800,188

Office Action Mailed: 12/15/2004 (December 15, 2004)

Reply to Office Action Dated: 05/06/2005 (May 6, 2005)

Page 10 of 11

unworkable.

Claim 1, as amended, recites that the handle portion extends from the top portion of the vertical member and extends outwardly from the front side of the vertical member. This permits the user to hold the planar article being hung by the handle of the inventive apparatus and to have the planar article behave largely as it will when hung. No pressure is exerted against any surface of the article to make the wall marking. This advantage cannot be achieved through any combination of the references cited.

Accordingly, it is respectfully submitted that the combination of Hofmeister and Wegman does not teach all of the limitations of claim 1 of the present invention, as amended, and that the combination when made would render the prior art unsuited for its intended purpose. Therefore, it is respectfully submitted that claim 1 is in presently in condition for allowance.

Appl. Ser. No: 10/800,188
Office Action Mailed: 12/15/2004 (December 15, 2004)
Reply to Office Action Dated: 05/06/2005 (May 6, 2005)

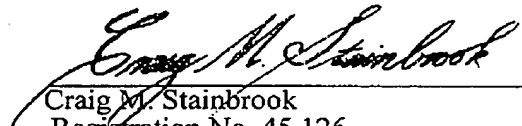
Page 11 of 11

IV. CONCLUSION

In view of these amendments and comments it is believed that each of the presently pending claims in this application is in condition for immediate allowance, and such allowance is therefore respectfully requested. The Examiner is invited to call Applicant's undersigned attorney if, in the opinion of the Examiner, a telephone conference will in any way expedite prosecution of this application.

Respectfully Submitted,

Date: 05/09/2005


Craig M. Stainbrook
Registration No. 45,126
JOHNSON & STAINBROOK, LLP
3558 Round Barn Blvd., Suite 203
Santa Rosa, CA 95403
Telephone (707) 578-9333
Attorneys for Applicant